

App No: 10/015,537
 Filed: 17 December 2001
 Office Action mailed: 29 December 2004
 Response filed: 25 February 2005

Remarks

The Office Action of 29 December 2004 states that the application is in condition for allowance, except for formal matters requiring the applicants to cancel the nonelected invention drawn to SEQ ID NO: 2. Applicants acknowledge that the prosecution on the merits is closed and have amended claims 1 and 13 to comply with the formal matters specified in the Office Action. However, applicants assert that the requirement to restrict the invention to SEQ ID NO: 1 is improper and respectfully request reconsideration. The arguments for this assertion are described below.

Election/Restriction

The Office Action states that amended claims 1, 5-13, and 16-24 are directed to an invention that is independent or distinct for the invention originally claimed because they are directed to two independent and distinct nucleic acid sequences. The Office Action has further required the applicants to cancel the nonelected invention drawn to SEQ ID NO: 2. The Office Action states that because the applicants have received an action on the merits for the originally presented invention, SEQ ID NO: 1 has been constructively elected for prosecution on the merits.

Applicants respectfully disagree with the restriction requirement. In the original specification applicants exemplified SEQ ID NO: 1 and SEQ ID NO: 2 as arcelin-5 promoters active in driving transcription of a heterologous coding sequence (Examples 4 and 5 on pages 40 and 41). Although a slightly shorter sequence, SEQ ID NO: 2 is 100% identical to SEQ ID NO: 1 along its length. Stated differently, SEQ ID NO: 2 can be defined as base pairs 3-1126 of SEQ ID NO: 1. The applicants assert that there would be no undue burden required of the Examiner because SEQ ID NO: 1 and SEQ ID NO: 2 comprise a common core structure and that core can be easily searched and examined. For these reasons, applicants feel that the requirement for restriction is improper and should be withdrawn.

Applicants also respectfully disagree that an election has been constructively made with respect to SEQ ID NO: 1. The original claims 1 and 13 included the language "a promoter having a nucleic acid sequence that is at least 94% identical to SEQ ID NO: 1". These claims were amended during prosecution to substitute the language "a promoter having a nucleic acid

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sequence of SEQ ID NO: 1 or SEQ ID NO: 2." Applicants assert that SEQ ID NO: 2 falls within the scope of "94% identical to SEQ ID NO: 1" in the original claim and is neither independent of, nor distinct from the originally claimed invention as required by MPEP § 821.03 and 37 CFR 1.145. For this reason, applicants feel that the requirement to cancel SEQ ID NO: 2 is improper and should be withdrawn.

Applicants respectfully request that the restriction requirement be withdrawn and the application be allowed with the claims presented in the applicant's response of October 6, 2004.

Should the Examiner have any questions regarding this application, the Examiner is encouraged to contact Applicants' undersigned representative at (847) 236-5101.

Respectfully submitted,



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